

## **REMARKS**

Claim 41 has been amended. No claims have been canceled, and no new claims have been added. Claim 61 was canceled previously in a response to an earlier Office Action. Claims 1-60 are pending.

### ***Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel***

The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

### ***Claim Rejections – Double Patenting***

The Office Action provisionally rejects claims 1-60 as conflicting with claims 1-33 of Application No. 10/840,889 and Application No. 10/614,394. The Examiner is requested to hold these rejections in abeyance pending an allowance of claims in this or the other applications.

### ***Claim Rejections - 35 USC § 103***

The Office Action rejects claims 1-5, 7-19, 21-25, 27-39, 41-45, and 47-59 under 35 USC § 103(a) as being unpatentable over Cho (US 6,834,048), Bertacchi (US 5,790,638) and Slotznick (US 7,058,356). The final Office Action rejected claims 6, 20, 26, 40, 46 and 60 under 35 USC § 103(a) as being unpatentable over the combination of Cho, Bertacchi, Slotznick and Musk (US 6,185,194 B1). These rejections are respectfully traversed.

### **I. The Independent Claims**

The independent claims (claims 1, 11, 21, 31, 41 and 51) recite patentable features not found in the cited references.

#### **A. The Trigger Limitation Is Not Taught In The Cited Art**

The independent claims recite a “call trigger” and “instructions for triggering” (the trigger limitations) that are neither taught nor suggested by the cited references. Specifically, the trigger limitations are recited in the claims as follows.

Claims 1 and 21:

the computing device generating a call trigger in accordance with the instructions in the search response, the call trigger to initiate a multi-leg phone call with a user telephone associated with the user phone number and a merchant telephone associated with the merchant phone number, the user telephone and the merchant telephone separate and distinct from each other and separate and distinct from the computing device.

Claim 41:

generate a call trigger in accordance with the instructions in the search response, the call trigger to initiate a multi-leg phone call with a user telephone associated with the user phone number and a merchant telephone associated with the merchant phone number, the user telephone and the merchant telephone separate and distinct from each other and separate and distinct from a computing device in which the processor is located.

Claims 11, 31 and 51:

instructions for triggering a multi-leg phone call with the merchant phone number and a user phone number associated with a user telephone separate and distinct from the server and the computing device

None of the cited prior art references teach or suggest, in whole or in part, alone or taken together, the trigger limitations quoted above. As such, the independent claims are patentable over the cited references.

The Office Action admits that the trigger limitation is not taught or suggested in Cho. The Office Action then asserts that Bertacchi’s teaching that responding “to an incoming call

made to a primary phone number by simultaneously calling specified secondary numbers” teaches generating a call trigger for initiating a multi-leg phone call. (Office Action, p. 4) However, we assert that Bertacchi neither teaches nor suggests the trigger limitation.

Generally, Bertacchi discloses using a “telephone switch to respond to an incoming call made to a primary telephone number by simultaneously and/or sequentially calling one or more specified numbers.” (Bertacchi, 1:61-64) More specifically, Bertacchi explains, “When the incoming call is received at the telephone switch, it recognizes that the calling party dialed primary number is associated with a subscriber desiring multi-leg calling. The switch responds by routing the incoming call over a number of different outgoing legs to the plurality of telephones at subscriber specified numbers.” (Bertacchi, 1:66-67, 2:1-5) Bertacchi thus discloses creating multiple outgoing legs to a subscriber’s additional telephone numbers, after the initial call is placed. That is, after the first half of the call has already been completed, multiple second legs are created in order to establish a connection to the called party.

Review of Bertacchi shows that Bertacchi does not teach or suggest the trigger limitations. As stated above, Bertacchi discloses creating a multi-leg call after the initial call is placed. Bertacchi teaches creating a multi-leg call by creating multiple outgoing call legs to the called party’s secondary numbers. This does not teach or suggest “generating a call trigger in accordance with the instructions in the search response, the call trigger to initiate a multi-leg phone call with a user telephone associated with the user phone number and a merchant telephone associated with the merchant phone number” or the other trigger limitation. As such, Bertacchi does not teach or suggest the trigger limitations. The other cited references do not teach the trigger limitations. Therefore, the independent claims are patentable over the cited references.

### **B. Three Separate And Distinct Devices Are Not Taught In The Cited Art**

The Office Action states that neither Cho nor Bertacchi “teach that the user telephone number and the merchant telephone number are distinct and separate from each other and the computing device.” (Office Action, p. 4) The Office Action then asserts that Slotznick teaches “using three or more different devices for transmitting, making and receiving telephone calls”. Yes, Slotznick teaches three or more devices, but it does not teach the devices claimed having the claimed limitations. We assert that the devices described in Slotznick fail to teach or suggest the limitations including the two telephones and computing device having the features recited in the independent claims.

Slotznick is directed to television system having a SetTop Box and a telephone 321 that doubles as a remote control for the SetTop Box 317, where the telephone may also be a cellular telephone. Slotznick teaches that the SetTop Box transmits a telephone number to the telephone, and the user initiates a telephone call by clicking a button on the phone. (Slotznick, 12:58 - 13:13) The Office Action also cites an alternate embodiment of Slotznick in which the phone number is not transmitted from the television receiver or SetTop box to the telephone. In this alternate embodiment, “phone numbers are transferred from the telemarketing service 405 to a data transmission service 407 which transmits the data to a wireless data receiver 409 in the TV phone 321”. (Slotznick, 15:37 – 16:28)

As such, the SetTop box in this embodiment does not teach the limitations of the claimed server or the claimed computing device. More specifically, the SetTop Box of Slotznick does not create, receive process or otherwise involve the “response”, the “dial link” and other limitations recited in the independent claims as being performed by or otherwise involving the computing device. As such, the functionality of the SetTop Box of Slotznick is wholly inapplicable to the computing device and the independent claims.

### **C. The Cited Art Does Not Teach A “Search Response” Having A “Dial Link”**

All of the independent claims recite a “search response” having a “dial link”. None of the cited references teach or suggest a “search response” having a “dial link”. The Office Action cites Cho for teaching these limitations. We disagree that Cho teaches these limitations, either alone or in combination with the other cited references.

Generally, Cho teaches allowing a caller to call a telephone number that he or she sees on a web page. More specifically, Cho teaches using a software program residing on a caller’s computer to receive a web page and then parse the web page before the caller views the web page. (Cho, 1:59-63) The software program searches and parses character strings in the web page to identify telephone numbers. (Cho, 1:59-63) The software program on the caller’s computer then transforms the telephone numbers into links that the caller can select to establish a call between the selected telephone number and the caller’s personal computer. (Cho, 1:63-67, 2:1-11)

The cited prior art does not teach or suggest all of the limitations of claim 1 for at least the following reasons.

First, the Office Action fails to show that Cho teaches or suggests “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link” as recited in claim 1. The Office Action states that “Cho explains that users may search the Web for contact phone numbers by using an input device and that it provides an automated, interactive and immediate real-time call connection capability for the web page user.” (Office Action, p. 2) However, the Office Action does not assert that Cho teaches or suggests “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link”. As such, the Office Action does not make a *prima facie* case of obviousness.

In addition, review of Cho shows that Cho does not teach or suggest “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link” as recited in claim 1.

In contrast, Cho discloses in step 404 of Figure 4 of Cho that a caller selects a URL and then a web page document is downloaded. Cho further discloses that “To access a particular web page, the caller specifies the URL of the desired web page and the browser downloads the web page document associated with the URL (step 404).” (Cho, 5:1-4) Importantly, Cho also discloses “parsing the web page document for detecting a character string indicative of a telephone number”, “modifying the character string”, and “providing the web page document including the modified character string to the browser”. (Cho, 1:60-66) As such, Cho’s teaching is specific to downloading a **particular** web page document, onto the caller’s computer and then parsing that web page document on the caller’s computer before providing the web page to the caller. That Cho parses a received web page and modifies a character string before providing the web page to a caller shows that Cho does not teach or suggest “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link”. As such, claim 1 is patentable over Cho since Cho does not teach or suggest “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link” as recited in claim 1.

Second, the Office Action fails to show that Cho teaches or suggests the three components of the “search response” recited in claim 1, namely “at least one hit corresponding to the search request”, “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”, and “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. The Office Action merely states that “Cho teaches that to place a call to a telephone number the caller selects the phone number by clicking on the underlined or highlighted text (ad, dial link)”. (Office Action, p. 3) However, the Office Action

wholly fails to assert that Cho teaches a “search response including” (1) “at least one hit corresponding to the search request”, (2) “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”, and (3) “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. As such, the Office Action fails to make a *prima facie* case of obviousness.

In addition, Cho does not teach or suggest the three components of the “search response” recited in the independent claims. Cho discloses “parsing the web page document for detecting a character string indicative of a telephone number”, “modifying the character string in the web page document into a link to the internet telephone service” and “providing the web page document including the modified character string to the browser.” (Cho, 1:61-66) Cho’s teaching thus is specific to detecting telephone numbers on a web page, and then modifying those telephone numbers into links on the web page. In contrast, claim 1 recites, “a search response including” (1) “at least one hit corresponding to the search request”, (2) “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”, and (3) “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. As such, Cho does not teach or suggest a “search response” including all three components recited in claim 1 and the other independent claims. Moreover, Cho also does not teach or suggest each of the three separate components of the “search response”.

More specifically, the first component of the search response recited in claim 1 is “a search response including at least one hit corresponding to the search request”. Cho does not teach or suggest “a search response including at least one hit corresponding to the search request”. Cho discloses “accessing the web page using a browser”. (Cho, 1:59-60) Cho discloses, “After the caller installs the Direct Dial software program, the caller can then invoke the browser application and access the internet, selecting web sites she wishes to view. To access a particular web page, the caller specifies the URL of the desired web page and the

browser downloads the web page document associated with the URL (step 404).” (Cho, 4:66-67, 5:1-4) Cho thus teaches a caller selecting a particular web site. As such, Cho does not teach or disclose “a search response including at least one hit corresponding to the search request”.

The second component of the search response recited in claim 1 is “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”. The Office Action fails to assert that Cho teaches or suggests “a search response including” “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”. Even using the argument asserted in the Office Action regarding claims 11, 31, and 51, that Figure 5B of Cho shows a web page “having ad data” (Office Action, p. 4), the Office Action still fails to show that Cho teaches or suggests “a search response including” “an ad having a dial link”. Cho states that Figure 5B “illustrates the same [downloaded] web page **after** the operation of the direct telephone dialing scheme of the present invention. The character strings in the web page that have been underlined have been designated as telephone numbers and can be used to activate internet telephone service”. (Cho, 6:38-43) (emphasis added) Cho thus clarifies that Figure 5B shows a modified web page wherein the telephone numbers are links that a user can select to place a phone call to that number. Even if *in arguendo* this portion of Cho suggests a “dial link” as claimed, Cho explicitly teaches adding the dial link to a web page **after** it has been downloaded. As such, the downloaded web page of Cho can not teach or suggest “a search response including” “an ad having a dial link”.

Further, Figure 5B shows “All Listings” for a yellow pages search result as stated in the Figure. However, a yellow page listing of phone numbers does not teach or suggest “a search response including” “an ad having a dial link”. Stated more simply, a listing of addresses and phone numbers does not teach or suggest an “ad”. As such, the Office Action also fails to show that Cho teaches or suggests “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”.



In addition, Cho does not teach or suggest “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”. Cho discloses “a method for initiating an internet telephone service from a web page containing **at least one telephone number**”. (Cho, 1:57-59) (emphasis added) Cho’s teaching is specific to a web page with at least one telephone number. Cho nowhere recites “**an ad**”. In contrast, claim 1 recites “a search response including” “an ad having a dial link”. As such, Cho does not teach or suggest “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”.

The third component of the search response recited in claim 1 is “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. The Office Action fails to show that Cho teaches or suggests “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. The Office Action states “Cho teaches that character strings indicative of a telephone number are modified into a link and then the system displays the telephone number.” (Office Action, p. 3) The Office Action further states “Cho teaches selecting and activating the link and initiating the telephone call to the telephone number represented by the link.” (Office Action, p. 3-4) However, the Office Action does not show that Cho teaches or suggests “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. As such, the Office Action fails to assert a *prima facie* case of obviousness because the Office Action does not show that Cho teaches or suggests “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”.

In addition, Cho does not teach or suggest “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. Cho instead discloses “launching a server side script at the internet telephone service for initiating a

telephone call to the telephone number". (Cho, 2:6-8) Cho also discloses that "the caller selects the designated telephone numbers by clicking on the underlined or hi-lighted text. **Because the designated telephone number is a link to an internet telephone service provider, selection of the telephone number launches the internet telephone service.**" (Cho, 6:45-50) (emphasis added) Because a link to an ISP is not a user phone number, Cho fails to teach or suggest "a search response including" "instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number".

Moreover, as shown in Figures 1A and 1B of Cho, Cho's teaching focuses on making a phone call between a PC and a phone. Cho recites, "FIG. 1A illustrates one embodiment of a communication system for providing audio communication between a personal computer and an audio communication device." (Cho, 2:8-20) In addition, Cho recites, "FIG. 1B illustrates another embodiment of a communication system for providing audio communication between a personal computer and an audio communication device where the personal computer is located behind a firewall." (Cho, 2:21-24) Cho's teaching thus discloses modifying a telephone number on a web page into a link which when selected launches a server side script running on the internet telephone service's server to place a call between the caller's personal computer and the phone number selected. As such, Cho teaches only a merchant phone number, if anything, to which a caller's personal computer is connected via the ISP. Therefore, Cho does not teach or suggest "a search response including" "instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a **user phone number**". (emphasis added)

To the extent the arguments in this section are directed to claim 1, they are also directed to the other independent claims to the extent the other independent claims recite the same or similar limitations. The other cited references fail to cure the deficiencies of Cho.

## **II. Claims 6, 20, 26, 40, 46, and 60**

The Office Action admits that Cho, Bertacchi and Slotznick do not teach “sending a message to a billing system to charge the merchant for the user activating the dial link”, but that Musk discloses this feature. We respectfully disagree.

The Office Action fails to show that Musk teaches or suggests “sending a message to a billing system to charge the merchant for the user activating the dial link” as recited in claims 6, 26, and 46. The Office Action states that Musk “teaches that a web site accessed to place a call has a directory with a phone icon for a business to allow call initiation; the web site contains billing information and the business directory provides reverse billing and can be used to bill the business for the telephone call instead of the user.” (Office Action, p. 8) However, the Office Action fails to assert that Musk teaches or suggests “sending a message to a billing system to charge the merchant for the user activating the dial link” as recited in claims 6, 26, and 46. That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “charg[ing] the merchant for the user **activating the dial link**” as claimed. (emphasis added) As such, the Office Action fails to make a prima facie case of obviousness. Similarly, the Office Action fails to assert that Musk teaches or suggests “sending a message to a billing system for charging for triggering the multi-leg phone call” as recited in claims 20, 40, and 60. That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “for charging for **triggering the multi-leg phone call**” as claimed. (emphasis added)

In addition, review of Musk shows that Musk does not teach or suggest “sending a message to a billing system to charge the merchant for the user activating the dial link” as recited in claims 6, 26, and 46. Musk discloses a web site having a business directory wherein the business directory “provides reverse billing for the listing, and thus can be used like an 800 service, to bill the business for the telephone call instead of the user”. (Musk, 2:6-9) However, Musk does not teach or suggest “sending a message to a billing system **to charge the merchant**

**for the user activating the dial link**” as recited in claims 6, 26, and 46. (emphasis added) That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “charg[ing] the merchant for the user activating the dial link” as claimed. Similarly, Musk does not teach or suggest “sending a message to a billing system for **charging for triggering the multi-leg phone call**” as recited in claims 20, 40, and 60. (emphasis added) That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “for charging for triggering the multi-leg phone call” as claimed. (emphasis added)

Because the combination of Cho, Bertacchi, Slotznick and Musk do not teach or suggest all of the limitations of claims 6, 20, 26, 40, 46, and 60 as discussed above, the Office Action fails to meet its burden of proving a *prima facie* case of obviousness. Therefore, claims 6, 20, 26, 40, 46, and 60 are patentable over the combination of Cho, Bertacchi, Slotznick and Musk. The rejection under 103(a) of claims 6, 20, 26, 40, 46, and 60 should be withdrawn.

***Conclusion***

The independent claims are patentable over the cited references for the reasons set forth above. By virtue of their dependency on the independent claims, the dependent claims are patentable over the cited references for the reasons cited above. As such, the dependent claims are patentable over the cited references by virtue of their dependency on the independent claims. It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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Mark Andrew Goldstein  
Reg. No. 50,759

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SoCal IP Law Group LLP  
310 N. Westlake Blvd., Suite 120  
Westlake Village, CA 91362  
Telephone: 805/230-1350  
Facsimile: 805/230-1355  
email: info@socalip.com